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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Toshiyuki BABA et al

Serial No. 09/673,937

Art Unit: 1651

Filed: October 24, 2000

Examiner: M. Meller

Title: Method of Stabilizing Enzyme and Enzyme Composition

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**REQUEST FOR RECONSIDERATION OF ADVISORY LETTER DATED
FEBRUARY 24, 2003**

Commissioner for Patents
Washington, D.C. 20231

Sir:

In reply to the Advisory Letter dated February 24, 2003, please consider the following:

The Advisory Letter of February 24, 2003 was based primarily on restriction practice. In this advisory Letter, the examiner has set out the position that newly presented claims 28-62 present an invention which is different from the invention which was previously considered in former claims 10-27. There are two points to be made with respect to the position taken by the examiner in this Advisory Letter.

FIRST POINT

The first point to be made is that claims 28-62 do not recite an invention which is different from what was previously claimed and acted upon.

Under this point, the examiner's attention is politely requested to canceled claims 21 and 27. Claim 21 was previously indicated to be allowable, and claim 27 was rejected. It is pointed out that both of these claims recite "A stabilized enzyme...". In other words, these claims recite a product, which is basically the same product as is recited in present claims 28-57.

While these claims differ slightly in the amount of details they recite, they do recite basically the same product. Even in US restriction practice, claims which recite the same product, even though in slightly different detail, are not restrictable. Thus, claims 28-57 recite the same invention as previously recited and acted upon in claims 21 and 27, and accordingly claims 28-57 cannot properly be held to be directed to an invention which is different from what was examined in the prior claims, and thus claims 28-57 deserve an action on the merits.

Further under this point, the present independent claims 58-62 recite a method. While the method recited in these claims does add some further detail to the method which was recited in previous independent claims 10-20 and 22-26, adding further detail and making the claims more specific is not cause for invoking restriction practice. Thus, claims 58-62 also deserve an action on the merits.

SECOND POINT

The second point to be made with regard to the Advisory Letter is that this application was filed under 35 USC 371. PTO Rules, see MPEP 1893.03(d), state that for purposes of restriction, an application filed under 35 USC 371 is to be treated under PCT practice, or under the considerations of "Unity of Invention" for determining if restriction is appropriate.

Unity of Invention practice goes about making a determination for restriction based on the question of "Do the different groups of claims specifically describe a unique **special technical feature**". In the present application, all of claims 10-62, whether presently or previously under consideration, recite the limitation of, and are based upon a consideration of an aminotransferase being stabilized.

All of these claims recite the same "special technical feature". Under the provisions of PCT Unity of Invention practice, as set forth in MPEP 1893.03(d), restriction between these claims is not permissible.

For the aid of the examiner, a portion of MPEP 1893.03(d) is cited below, with sections which are particularly relevant to the present situation emphasized.

Examiners are reminded that unity of invention (not restriction) practice is applicable in international applications (both Chapter I and II) and in national stage (filed under 35 U.S.C. 371) applications. Restriction practice continues to apply to U.S. national applications filed under 35 U.S.C. 111(a).

When making a lack of unity of invention requirement, the examiner must (1) list the different groups of claims and (2) explain why each group lacks unity with each other group (i.e., why there is no single general inventive concept) specifically describing the unique special technical feature in each group.

The principles of unity of invention are used to determine the types of claimed subject matter and the combinations of claims to different categories of invention that are permitted to be included in a single international or national stage patent application. The basic principle is that an application should relate to only one invention or, if there is more than one invention, that applicant would have a right to include in a single application only those inventions which are so linked as to form a single general inventive concept.

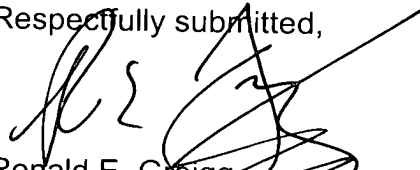
A group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. The expression "special technical features" is defined as meaning those technical features that define the contribution which each claimed invention, considered as a whole, makes over the prior art. For example, a corresponding technical feature is exemplified by a key defined by certain claimed structural characteristics which correspond to the claimed features of a lock to be used with the claimed key. Note also examples 1-17 of Annex B Part 2 of the PCT Administrative Instructions as amended July 1, 1992 contained in Appendix AI of the MPEP..

A process is "specially adapted" for the manufacture of a product if the claimed process inherently produces the claimed product with the technical relationship being present between the claimed process and the claimed product. The expression "specially adapted" does not imply that the product could not also be manufactured by a different process.

An apparatus or means is specifically designed for carrying out the process when the apparatus or means is suit-able for carrying out the process with the technical relationship being present between the claimed apparatus or means and the claimed process. The expression "specifically designed" does not imply that the apparatus or means could not be used for carrying out another process, nor does it imply that the process could not be carried out using an alternative apparatus or means.

Accordingly, Claims 28-62 should now be examined. In view of the arguments presented in the amendment of November 21, 2002, claims 28-62 are believed to be in condition for allowance, and a notice to that effect is respectfully requested.

Respectfully submitted,



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Date: March 12, 2003

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